



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/685,143 | 10/14/2003 | Jay S. Walker | 02-040 | 4772 |
| 22927 | 7590 | 10/05/2005 | EXAMINER | |
| WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905 | | | JONES, SCOTT E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3713 | |
| DATE MAILED: 10/05/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/685,143 | Applicant(s) WALKER ET AL. | |
| | Examiner Scott E. Jones | Art Unit 3713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 21-26, 36-40, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 21-26, 36-40, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06092005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on January 27, 2005 in which applicant cancels claim 35 and acknowledges the indication for allowability to claims 1-6, 21-26, 36-40, and 55-56. Claims 1-6, 21-26, 36-40, and 55-56 are pending.
2. The indicated allowability of claims 1-6, 21-26, 36-40, and 55-56 is withdrawn in view of the newly submitted reference(s) to LeMay et al. (U.S. Pub. No. 20050096125). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1-6, 21-26, 36-40, and 55-56 are rejected under 35 U.S.C. 102(e) as being anticipated by LeMay et al. ("LeMay") (U.S. 6,942,574).

LeMay discloses a method and apparatus for providing entertainment content, such as movies, TV programming, audio programming, advertising, e-mail, stock quotes, news, and personal messaging, etc., that is of particular interest to a player on a gaming machine based on player tracking and separate player identification history. LeMay additionally discloses:

Regarding Claim 1:

Art Unit: 3713

- determining a message (Abstract, Figures 4-6, Column 1, lines 7-11, Column 2, lines 15-29, Column 2, line 55-Column 3, line 3, Column 3, lines 7-60, Column 4, lines 44-57, 64-67, Column 5, lines 8-12, 21-58, Column 6, lines 19-30, Column 7, lines 1-18, 26-40, Column 7, line 55-Column 8, line 21, Column 8, lines 33-44, Column 8, line 58-Column 9, line 10, Column 9, lines 26-31, 60-67, Column 10, lines 28-35, Column 11, line 15-Column 12, line 49, Column 13, lines 45-67, and Column 14, lines 1-21);
- identifying a game machine (*Id.*);
- determining gaming activity associated with a player (*Id.*);
- determining a feature of the game machine, the feature being selected based on the gaming activity, wherein the feature that may be activated based on a selection by the player (*Id.*); and
- outputting the message to a player via the game machine, the message comprising a recommendation of the feature (*Id.*).

Regarding Claim 2:

- wherein determining the message includes determining a status message (*Id.*).

Regarding Claim 3:

- wherein determining the message includes determining an instructive message (*Id.*).

Regarding Claim 4:

- wherein determining the message includes determining a communication message (*Id.*).

Regarding Claim 5:

- wherein determining the message includes determining a promotional message (*Id.*).

Regarding Claim 6:

- wherein determining the message includes determining an activity-benefit offer (*Id.*).

Regarding Claim 21:

- determining a message (*Id.*);
- determining a gaming activity of a player (*Id.*); and
- outputting the message to the player via a game machine based on the gaming activity of the player (*Id.*).

Regarding Claim 22:

- wherein determining the message includes determining a status message (*Id.*).

Regarding Claim 23:

- wherein determining the message includes determining an instructive message (*Id.*).

Regarding Claim 24:

- wherein determining the message includes determining a communication message (*Id.*).

Regarding Claim 25:

- wherein determining the message includes determining a promotional message (*Id.*).

Regarding Claim 26:

- wherein determining the message includes determining an activity-benefit offer (*Id.*).

Regarding Claim 36:

- determining a message (*Id.*);

Art Unit: 3713

- determining a first representation of the message and a second representation of the message (*Id.*);
- outputting the first representation of the message to a first player at a game machine (*Id.*); and
- outputting the second representation of the message to a second player at a game machine (*Id.*);
- wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second representation includes selecting a representation based upon a characteristic of the second player (*Id.*).

Regarding Claim 37:

- wherein the first representation is different from the second representation (*Id.*).

Regarding Claim 38:

- determining a message (*Id.*);
- determining a first representation of the message and a second representation of the message (*Id.*);
- outputting the first representation of the message to a first player at a game machine (*Id.*); and
- outputting the second representation of the message to a second player at a game machine (*Id.*);
- herein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second

representation includes selecting a representation based upon an indication by the second player (*Id.*).

Regarding Claim 39:

- wherein the first representation is different from the second representation (*Id.*).

Regarding Claim 40:

- determining a message to be output to a player at a game machine (*Id.*); and
- suppressing output of the message, wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied (*Id.*).

Regarding Claim 55:

- determining an occurrence of a trigger condition (*Id.*);
- identifying a message in a database of messages based on the trigger condition (*Id.*);
- identifying a game machine from among a plurality of game machines based on the message (*Id.*);
- suppressing output of the message until a second trigger condition is satisfied (*Id.*);
and
- displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition, wherein the partition is a pop-up window, and wherein the identified message includes a feature recommendation (*Id.*).

Regarding Claim 56:

- data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity (*Id.*).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Brossard '790, Gura '411, Walker et al. '431, Dunn '975, Falciglia '849, disclose gaming systems and methods for providing messaging and other entertainment to players at gaming machines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Primary Examiner
Art Unit 3713



SEJ